

REMARKS

Claims 1-18 were pending in this application.

Claims 1-18 have been rejected.

Claims 1, 11, 13, 16 and 18 have been amended as shown above.

Claims 19 and 20 have been added.

Claims 1-20 remain pending in this application.

Reconsideration of Claims 1-20 is respectfully requested.

I. IN THE SPECIFICATION

The Cross-Reference to Related Applications has been amended to replace docket numbers with U.S. Patent Application numbers. The Applicants respectfully assert that no new matter has been added and requests entry of the proposed amendments to the specification.

II. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1-10 and 13-15 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2001/0018660 A1 to Sehr ("Sehr"). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. §102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP §2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir.

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1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP §2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

As amended, independent Claims 1 and 13 recite a method and system in which an application program is downloaded into a virtual ticket device for use in connection with an electronic ticket control system. The *Sehr* reference describes a visitor card onto which may be loaded information and data such as seat assignments [0048], monetary values and electronic payment forms [0049], electronic tickets [0051], entrance and exit stamps [0052]. The visitor cards may be so-called “smart” cards, “handheld terminals or any pocket sized computer configurations” [0035]. However, *Sehr* does not teach downloading programs onto the visitor cards. Thus, *Sehr* does not anticipate downloading an application program into a virtual ticket device for use in connection with an electronic ticket control system, as recited in amended independent Claims 1 and 13.

For this reason, *Sehr* fails to anticipate each and every limitation of the Applicants’ invention arranged as they are in amended independent Claims 1 and 13 (and Claims 2-10, 14 and 15, depending therefrom). Accordingly, the Applicants respectfully request withdrawal of the § 102 rejections and full allowance of Claims 1-10 and 13-15.

III. REJECTIONS UNDER 35 U.S.C. § 103

The Office Action rejects Claims 11, 12 and 16-18 under 35 U.S.C. § 103(a) as being unpatentable over *Sehr*. This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

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modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. MPEP § 2142.

Claims 11, 12, 16 and 17 depend directly from amended independent Claims 1 and 13 and include the limitations of their respective base claims. Thus, for the reasons described above with regard to Claims 1 and 13, *Sehr* does not teach or suggest all the limitations of Claims 11, 12, 16 and 17. Therefore, a *prima facie* case of obviousness has not been established.

With regard to amended independent Claim 18, this claim too recites the limitation of downloading into a virtual ticket device an application for use in connection with an electronic ticket control system. Thus, for the reasons described above with regard to Claim 1, *Sehr* does not teach or suggest all the limitations of amended independent Claim 18. Therefore, a *prima facie* case of obviousness has not been established.

The Applicants respectfully request that the rejection of Claims 11, 12 and 16-18 under 35 U.S.C. § 103(a) be withdrawn and that Claims 11, 12 and 16-18 be passed to allowance.

IV. NEW CLAIMS

The Applicants have added new Claims 19 and 20 and respectfully submit that no new matter has thereby been added. Claims 19 and 20 depend from independent Claim 1 and include its limitations. Therefore, the Applicants respectfully assert that the new claims are patentable over the cited prior art and request full allowance of Claims 19 and 20.

V. CONCLUSION

For the reasons given above, the Applicants respectfully request reconsideration and full allowance of all pending claims and that this application be passed to issue.

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SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at wmunck@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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